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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,871	06/21/2006	Michel Croquenoy	CROQUENOY1	8993

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EXAMINER	
UHLIR, CHRISTOPHER J	

ART UNIT	PAPER NUMBER
2837	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/583,871	CROQUENOY, MICHEL	
	Examiner	Art Unit	
	CHRISTOPHER UHLIR	2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Receipt is acknowledged of applicant's response filed September 16, 2008. Claims 1-14 are pending and an action on the merits is as follows.

Objection to drawing is withdrawn.

Objection to claim 14 is withdrawn.

Applicant's arguments with respect to claims have been considered and are addressed below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lancie et al. (US 3,161,102) in view of Kelischek (US 3,308,707).

Regarding claim 1, Lancie et al. discloses an oboe shown in Fig. 1 to have an elongate body having a first portion or upper joint U and a second portion or lower joint L that are adapted to be nested one in the other. Said first portion U is further shown to carry an onion or ferrule 5 at one end 9, adapted to receive a reed 6 (column 4 lines 8-10). Said second portion L is shown to be nested with a horn or bell joint B. A plane of transverse nesting of said first portion U and said second portion L is further shown to

be situated between lines d and e, located octave holes and note holes. Lancie et al. fails to explicitly disclose that note holes to be only in the second portion and the horn.

However Kelischek teaches a double reed woodwind instrument resembling an oboe, shown in FIG. 1 to have an elongate body, a first portion or reed cap base 54, and adapted to receive a second portion 18. A plane of transverse nesting between these two portions is further shown to be near the top of the instrument, where no note holes are located in said first portion 54.

Given the teachings of Kelischek, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the oboe disclosed in Lancie et al. with providing the plane of transverse nesting near the top of the instrument so that note holes are only in the second portion and the horn. It has been held that rearranging parts of an invention involves only routine skill in the art. In *re Japikse*, 86 USPQ 70. Doing so would provide an "improvement of the relative intonation of different portions of the range of the instrument while at the same time maintaining or improving the character and quality of the tone produced by the instrument" as stated by Lancie et al. (column 1 lines 15-19).

In reference to claims 2 and 3, Lancie et al. modified by Kelischek discloses an oboe having a transverse nesting plane situated between the octave holes and the note holes as stated above, but fails to explicitly disclose said transverse nesting plane to be situated between the octave holes and trill holes, so the first body portion includes only octave holes.

However it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the transverse nesting plane to be situated between the octave holes and trill holes, so the first body portion includes only octave holes, since it has been held that rearranging parts of an invention involves only routine skill in the art. In *re Japikse*, 86 USPQ 70. Doing so would provide an "improvement of the relative intonation of different portions of the range of the instrument while at the same time maintaining or improving the character and quality of the tone produced by the instrument" as stated by Lancie et al. (column 1 lines 15-19).

In reference to claim 4, Lancie et al. modified by Kelischek discloses an oboe as stated above, but fails to explicitly disclose the G sharp key to extend partly under the E flat key.

However it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the G sharp key to extend partly under the E flat key, since it has been held that rearranging parts of an invention involves only routine skill in the art. In *re Japikse*, 86 USPQ 70. Doing so would provide a "reasonable degree of accuracy in the pitch relationship" within a desired range as stated in Lancie et al. (column 1 lines 48-52).

In reference to claims 5, 6, 10, and 12-14, Lancie et al. modified by Kelischek discloses an oboe as stated above, but fails to explicitly disclose the first portion or oboe head to have a length of substantially 102 mm.

However it would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made to provide the first portion or

oboe head to have a length of substantially 102 mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In *re Rose*, 105 USPQ 237 (CCPA 1955). Doing so would allow mass production of the oboe where each instrument would have the same measurements and the same qualities.

In reference to claim 7, Lancie et al. modified by Kelischek discloses an oboe as stated above, but fails to explicitly disclose the second portion to have a length of substantially 370 mm.

However it would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made to provide the second portion to have a length of substantially 370 mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In *re Rose*, 105 USPQ 237 (CCPA 1955). Doing so would allow mass production of the oboe where each instrument would have the same measurements and the same qualities.

In reference to claim 8, Lancie et al. discloses an oboe as stated above, but fails to disclose an accessory in the form of another first portion that is interchangeable with the first portion.

However Kelischek teaches a double reed woodwind instrument resembling an oboe, shown in Fig. 3 to have an accessory or crook 104 that resembles a portion or lower end 26 of the instrument and is interchangeable with said portion 26 (column 3 lines 65-70).

Given the teachings of Kelischek, it would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made to modify the oboe disclosed by Lancie et al. with an accessory in the form of another portion, such as the first portion that is interchangeable with that portion. Doing so would provide emergency parts that could be borrowed when needed in order to properly play the instrument, as taught by Kelischek (column 4 lines 60-62).

In reference to claim 9, Lancie et al. modified by Kelischek discloses an oboe having a first portion or oboe head carrying an onion at one end adapted to receive a reed, and is adapted to be nested with a second body portion as stated above.

In reference to claim 11, Lancie et al. modified by Kelischek discloses an oboe as stated above, where the first portion or oboe head typically has trill holes.

Response to Arguments

Applicant's arguments filed September 16, 2008 have been fully considered but they are not persuasive.

Applicant states on page 7 of the response that "Kelischek does not concern an oboe but discloses a krummhorn." Lancie et al. was relied on to disclose an oboe having most of the structural limitations of applicant's claims, but failed to disclose note holes to be only in the second portion and the instrument. Kelischek was relied on to teach this limitation since it represents a woodwind instrument which is similar to an oboe. Therefore given the teachings of Kelischek, it would have been obvious to one of

ordinary skill in the art to provide tone holes only in a second portion of the instrument, as stated above.

Applicant further states that "separating the body of an oboe into three parts, as opposed to two, with its keys for covering the various holes is a more difficult task than separating the body of a krummhorn". However it should be noted that oboes typically are separated into three parts for storage and travel. The Kelischek reference merely teaches repositioning the plane of transverse nesting of two portions so that the tone holes would be located only in a second portion. Although this may be more difficult on an oboe than on a krummhorn, this statement does not prove that it would not be obvious to one of ordinary skill in the art. One would recognize that this modification could be made on an oboe. Therefore the combination of Lancie et al. with Kelischek properly discloses applicant's invention as claimed.

The fact that the "oboe and the krummhorn are both very old instruments and have existed in their current configuration for several hundred years without change" as stated by applicant, does not provide evidence that any modification to the instruments would be non-obvious to one of ordinary skill in the art. Modifications to the oboe have been proposed, and some implemented even as recent as 2004 (US 6,706,958 B1). Therefore applicant's statement that these instruments are very old and have experienced few major changes over the years does not provide evidence of non-obviousness.

On page 8 of the response, applicant states that "should one of ordinary skill in the art consider the teachings of Kelischek for modifying an oboe body, he would have

been instructed to provide the plane of transverse nesting not between the octave holes and note holes, but just near the onion receiving reed." However it has been held to be within the level of ordinary skill in the art for a person that known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art. *KSR* 550 U.S. at _, 82 USPQ2d at 1396. Since Kelischek discloses a similar device to the oboe disclosed by Lancie et al., and the differences between the claimed invention and the prior art would be encompassed in variations of the teachings of Kelischek, then the combination of Lancie et al. with Kelischek would properly render applicant's claimed invention obvious.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER UHLIR whose telephone number is (571)270-3091. The examiner can normally be reached on Monday-Thursday 8:00am-6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Benson can be reached on 571-272-2227.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER UHLIR/
Examiner, Art Unit 2837
November 25, 2008

/Jeffrey Donels/

Primary Examiner, Art Unit 2837